

REMARKS/ARGUMENTS

Favorable reconsideration of the present application is respectfully requested.

The Official Action dated May 20, 2003, contained an objection to the specification under 35 USC §132, asserting that the changes proposed in the Amendment filed March 3, 2003, contained new matter. While Applicant disagrees with the Examiner's position, the amendments made in the specification herein operate to return the specification to its original condition i.e., the English language version presented in the Supplemental Preliminary Amendment filed July 16, 2001). In view of this change, the objection to the specification under 35 USC §132 is obviated, and should be withdrawn.

Claims 1-5 and 7 were again rejected under 35 USC §103(a) as being unpatentable over the disclosure in the specification at page 1, line 13, through page 2, line 16. Claims 1-7 were also rejected under 35 USC §103(a) as being obvious in view of Niemann et al. (U.S. 4,163,827) and the disclosure at pages 1 and 2 of the present specification. The Official Action notes that these rejections are based upon the "reasons of record".

Reverting to the Official Action dated December 3, 2002, one of the "reasons of record" includes a citation to page 2, lines 12-15 of the specification, which states that:

[I]t is known to cover the metallic sheath with a wrapping which, being combustible without leaving any harmful residues, momentarily retards the propagation of heat to the core of the cored wire. This combustible wrapping is wound in a helix around the metallic sheath.

Based upon this passage, the Official Action concludes that it would have been obvious to make the claimed invention, which is a cored wire surrounded by a

metallic casing, with the metallic casing being covered with a wrapping which is combustible without leaving any harmful residues, and which momentarily retards the propagation of heat to the core of the cored wire. A similar conclusion, based upon the same passage, is reached in the rejection of Claims 1-7 under 35 USC §103(a) in view of Niemann and the present specification.

As noted in the response filed March 3, 2003, the above-quoted passage was referring to an aspect of the present invention, and not something which was generally known in the art. As evidence that the above-quoted passage is not directed to subject matter which was generally known in the art, and instead relates to and refers to subject matter invented by the present inventors, submitted herewith (see Appendix) is a Declaration Under 37 CFR 1.132, executed by Jean-Claude Becart, one of the named co-inventors in this application. The other co-inventor, Dominique Riche, is no longer employed by the assignee, and was not available to execute the Declaration alongside Mr. Becart. (Declaration, ¶2).

The Declaration establishes that the passage quoted above, which forms the principal basis for the rejection of the claims in this application, is, in fact, making reference to the work performed by these same two co-inventors, as presented in French patent application No. 00.8284, filed June 28, 2000, upon which the present application claims priority. The Declaration further establishes that, to the knowledge of Mr. Becart, the technical solution set forth in French application No. 00.08284, and in the passage quoted above, was not generally known to the public, was disclosed only in that French application, and was believed to be patentable to these co-inventors.

The Declaration also evidences that the passage quoted above was presented to delineate or the difference between the invention disclosed in French application

No. 00.08284, and a further invention being disclosed in French application No. 0102948, filed March 5, 2001, involving further providing a metallic casing over the combustible wrapping.

It is thus clear on the record that the disclosure at page 2, lines 12-15 of the present application represents the work and invention of the co-inventors of this application. The fact that these very aspects of the invention are being claimed in Claim 1 and in other rejected claims, evidences that these co-inventors have always believed, and continue to believe this to be an invention that is patentable to them, and that the construction of the wire discussed in the passage is not within the prior art.

Applicant acknowledges that, under particular circumstances, a reference or information can become prior art by an applicant's admission. Such circumstances are not present here. To the contrary, it is clear on the record that the passage relied upon in the rejections does not constitute prior art. In Riverwood International Corp. v. R. A. Jones & Co., 66 USPQ2d 1331 (Fed. Cir. 2003), the Federal Circuit specifically held that the doctrine by which an admission can make a reference available as prior art, is inapplicable when the subject matter at issue is the inventor's own work. Riverwood, 66 USPQ2d at 1337 (emphasis added).

In the Riverwood case, the Federal Circuit reiterated the policy set forth in Reading & Bates Construction Co. v. Baker Energy Resources Corp., 223 USPQ 1168 (Fed. Cir. 1984), to the effect that:

[T]here is an important distinction between the situation where the inventor improves upon his own invention and the situation where he improves upon the invention of another. In the former situation, where the inventor continues to improve upon his own work product, his foundational work product should

not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own mark.

Reading & Bates, 223 USPQ at 1172. (emphasis added)

Based upon this policy, the court in Riverwood concluded that, “[O]ne’s own work may not be considered prior art, in the absence of a statutory basis...”

Riverwood, 66 USPQ2d at 1338. In the present case, the evidence (Declaration) establishes that the alleged “prior art” is, in fact, the applicant’s own work. Further, no basis exists to place that information from the specification into a statutory category of “prior art”. Accordingly, the disclosure at page 2 of the specification is not available as “prior art” to be asserted against the claims.


Since both grounds of rejection under 35 USC §103(a) rely, in significant part, on the assertion that the passage at page 2 of the specification is prior art citable against the instant claims, and that a significant aspect of the claimed invention is disclosed or rendered obvious by this alleged “prior art”, the grounds of rejection do not, and cannot, establish a legitimate prima facie case of obviousness as to Claims 1-7 presented herein. Reconsideration and withdrawal of the rejections of Claims 1-5 and 7, under 35 USC §103(a) and of Claims 1-7, are warranted and are respectfully requested.

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Applicant believes that the claims are, in all other respects, in condition for allowance. Passage of the application to issue at an early date is thus earnestly solicited.

Respectfully,

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